

Remarks

Favorable reconsideration of this application, in view of the above amendments and in light of the following remarks and discussion, is respectfully requested.

Applicant respectfully requests entry of this response, as the response places the application in clear condition for allowance, or alternatively places the claims in better form for appeal. Specifically, Applicant has amended the claims to overcome an outstanding objection, and respectfully submits remarks distinguishing the claims from the applied references.

Upon entry of this response, Claims 1-40 are currently pending in the application; Claims 24, 29, 33, and 37 having been amended. Applicant respectfully asserts that support for the changes to the claims is self-evident from the originally filed disclosure, including the original claims, and that therefore no new matter has been added.

In the outstanding Office Action, Claims 24 and 37 were objected to because of informalities; Claims 1-3, 5, 6, 11, 12, 17, and 39 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,043,033 to Fyfe; Claims 13-15, 22, and 23 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,219,991 to Salek-Nejad; Claims 26, 30, 32, 34, and 35 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,924,262 to Fawley; Claims 28 and 38 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,892,601 to Norwood; Claim 18 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Salek-Nejad in view of Fyfe; Claims 24 and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,607,527 to Isley, Jr. (Isley) in view of one of U.S. Patent Nos. 3,541,745 or 3,763,609 to Probst¹ (the Probst patents) and further in view of U.S. Patent No. 5,105,944 to Ingalls et al. (Ingalls) and U.S. Patent No. 5,925,579 to Neuner et al. (Neuner); Claims 7-10

¹ Applicants respectfully request the Examiner's clarification as to which of the Probst patents have been used in the rejection of the claims.

were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fyfe; and Claims 19-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Salek-Nejad.

Initially, Applicant expresses thanks for the Examiner's allowance of Claims 4, 16, 27, 29, 31, 33, 36, 37, and 40 are allowed.

As stated above, Claims 24 and 37 were objected to because of informalities. In response, Applicant has amended Claims 24 and 37, as well as Claims 29 and 33, in a non-narrowing manner to remedy informalities. Thus, Applicant respectfully requests that the objection to Claims 24 and 37 be withdrawn.

As stated above Claims 1-3, 5, 6, 11, 12, 17, and 39 were rejected under 35 U.S.C. § 102(b) as being anticipated by Fyfe. Claims 13-15, 22, and 23 were rejected under 35 U.S.C. § 102(e) as being anticipated by Salek-Nejad. Claims 26, 30, 32, 34, and 35 were rejected under 35 U.S.C. § 102(e) as being anticipated by Fawley. Claims 28 and 38 were rejected under 35 U.S.C. § 102(b) as being anticipated by Norwood. Claim 18 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Salek-Nejad in view of Fyfe. Claims 24 and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Isley in view of the Probst patents and further in view of Ingalls and Neuner. Claims 7-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fyfe. Claims 19-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Salek-Nejad. Applicant respectfully requests that the rejections of the claims be withdrawn for the following reasons.

The present invention is directed to methods for reinforcing a structure with a high-ductility material, configurations for reinforcing a structure with the high-ductility material, cored rolls of the high ductility material, and the high-ductility materials. Independent Claims 1, 13, 24, 26, 28, 30, 32, 34, 35, 38, and 39 each recite the high-ductility material having an initial elastic modulus lower than an elastic modulus of concrete.

Regarding the rejection of independent Claims 1 and 39, the Office Action asserts that the narrow tape of Fyfe is analogous to the claimed features of a high-ductility material, as recited in the independent claims. Applicant respectfully asserts that even if Applicant agreed with this assertion, which Applicant does not, the Office Action still does not teach, or render obvious, the claimed features recited in independent Claims 1 and 39.

Specifically, Applicants respectfully assert that Fyfe does not teach, or render obvious, the claimed features of a high-ductility material having an initial elastic modulus lower than an elastic modulus of concrete. Applicants respectfully traverse the Office Action assertions that “because the . . . tape 42 comprises a fibrous origin, its initial elastic modulus is inherently lower than the elastic modulus of concrete.”

MPEP § 2112 states that “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic.” (Underlining original). Rather, “[t]o establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” In this case, Applicant respectfully asserts that the Office Action has provided no extrinsic evidence that in the narrow tape 42 of Fyfe, whether including fibers or not, an initial elastic modulus lower than an elastic modulus of concrete is necessarily present. Rather, Applicant respectfully asserts that the Office Action has broadly asserted the conclusory statement that the narrow tape 42 has the claimed initial elastic modulus.

Further, MPEP §2144.05 (II) (B) state that “[a] particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be

characterized as routine experimentation.” (Underlining added). In this case, Applicant respectfully asserts that because Fyfe does not state that any recognized result is achieved by altering an initial elastic modulus of the narrow tape 42, Fyfe does not recognize such an initial elastic modulus as a result-effective variable. Thus, Applicant respectfully asserts that the Office Action has not established that it would have been obvious to even modify an initial elastic modulus of the narrow tape 42 of Fyfe.

Specifically, independent Claims 1 and 39 recite “disposing a high-ductility material having an initial elastic modulus lower than an elastic modulus of concrete.” Therefore, Applicants respectfully request that the rejection of independent Claims 1 and 39 under 35 U.S.C. § 102(b) be withdrawn, and the allowance of independent Claims 1 and 39.

For reasons similar to those discussed above with respect to independent Claims 1 and 39, Applicant respectfully request that the rejections of independent Claims 13, 24, 26, 28, 30, 32, 34, 35, and 38 be withdrawn, and the allowance of independent Claims 13, 24, 26, 28, 30, 32, 34, 35, and 38.

Applicants respectfully assert that Claims 2, 3, 5-12, 14, 15, 17-23, and 25 are allowable for the same reasons as the independent claims from which they depend, as well as for their own features. Thus, Applicants respectfully request that the rejections of dependent Claims 2, 3, 5-12, 14, 15, 17-23, and 25 be withdrawn, and the allowance of dependent Claims 2, 3, 5-12, 14, 15, 17-23, and 25.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1-40 is earnestly solicited.

Application No. 10/089,108
Reply to Office Action of May 14, 2004

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact the undersigned representative at the below listed telephone number.

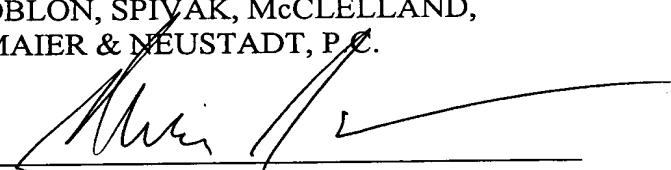
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Respectfully submitted,

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